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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,430	11/23/2001	Vincet Rajgarhia	00-1237-A	5475
20306	7590	06/23/2004	EXAMINER	
MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606			PAK, YONG D	
			ART UNIT	PAPER NUMBER
			1652	

DATE MAILED: 06/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/992,430	<b>Applicant(s)</b> RAJGARHIA ET AL.	
	<b>Examiner</b> Yong D Pak	<b>Art Unit</b> 1652	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,4 and 7-23 is/are pending in the application.
- 4a) Of the above claim(s) 16-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-4 and 7-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The amendment filed on February 27, 2004, amending claims 3, 4 and 7 and canceling claims 2 and 5-6, has been entered.

Claims 1, 3-4, 7-23 are pending.

### ***Election/Restrictions***

Applicant's election with traverse of Group I in Paper No. 21 is acknowledged.

Claims 16-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 21.

Notice of Possible Rejoinder: The Examiner notes that if claims 1, 3-4 and 7-15 are found directed to an allowable product, then claims 16-23, which are directed to the process of using the patentable product, previously withdrawn from consideration as a result of a restriction requirement, would now be rejoined pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86; see also MPEP 821.04, *In re Ochiai*, and *In re Brouwer*). Since process claims 16-23 would be rejoined and fully examined for patentability under 37 CFR 1.104, applicants are instructed to amend said claims as deemed necessary according to rejections made against the elected claims.

***Information Disclosure Statement***

The information disclosure statement filed on November 25, 2002 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Applicants have agreed to provide copies of the following references.

Danner et al. Applied Biochemistry and Biotechnology Vol. 70-72 (1998)

Gunge et al. J. Bacteriol. 145 :382-390 1981.

Ito et al. J. Bacterol. 153 :163-168 (1983)

Naumov et al. 1990, MGG 224 :119-128

Sambrook et al. 1989, Molecular Cloning, 2<sup>nd</sup> Ed.

Witte et al. J. Basic Microbial. 29:707-716 (1989)

***Response to Arguments***

***Claim Rejections - 35 USC § 112***

Applicant's arguments filed on February 27, 2004, with respect to the rejection of claims 3-4 under 35 U.S.C. 112, second paragraph have been fully considered and are persuasive. The rejection of claims 3-4 under 35 U.S.C. 112, second paragraph has been withdrawn.

***Claim Rejections - 35 USC § 102***

Applicant's arguments filed on February 27, 2004, with respect to the rejection of claims 1, 3-4 and 7-15 under 35 U.S.C. 102(e) have been fully considered and are not persuasive.

Applicants argue that the reference of Rajgarhia et al. (U.S. Patent No. 6,485,947) does anticipate the instant claims because the reference does not disclose the amino acid sequence encoded by the lactate dehydrogenase gene derived from *Kluyveromyces thermotolerans* (ATCC 52709). The examiner disagrees.

*Kalman v. Kimberly-Clark*, 713 F.2d 760,771 Fed. Cir. 1983 as cited by applicants teach that in order to support a rejection of a claim under 35 U.S.C. 102, it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. In the instant case, even though the amino acid sequence nor the nucleic acid sequence of the lactate dehydrogenase gene from *K. thermotolerans* is not explicitly described, the lactate dehydrogenase gene of Rajgarhia et al. and the lactate dehydrogenase gene of the instant invention are identical. They are both derived from the same strain of *K. thermotolerans* (ATCC 52709) (Column 28, line 57 through Column 29 line 54) and they were both derived by using similar cloning techniques, using degenerate amplification primers designed from conserved regions of identified lactate dehydrogenase genes

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(Column 29, lines 16-54). Therefore, the teachings of Rajgarhia et al. anticipate claims 1, 3-4 and 7-15.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

No claim is allowed.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Pak whose telephone number is 703-308-9363. The examiner can normally be reached on 6:30 A.M. to 5:00 P.M. Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Yong D. Pak

June 16, 2004



PONNATHAPU ACHUTAMURTHY  
SUPERVISOR/ART UNIT 1652  
TELEPHONE 703-308-3804